

Remarks/Arguments

The Rejection of Claims 1-4, 6-11, 15, 20, and 23 Under 35 U.S.C. §102

In the Office Action of May 10, 2004, the Examiner rejected Claims 1-4, 6-11, 15, 20, and 23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,733,083 (Heminger). Applicant respectfully traverses the rejection.

Anticipation requires that all of the elements of the claim be taught within the four corners of a single reference.

Heminger does not disclose an outer surface having an adhesive thereon

Amended Claim 1 recites a fastener with an outer surface and at least a portion of the outer surface having an adhesive thereon. Heminger does not disclose this element. Instead, Heminger teaches an adhesive insert, not coated with an adhesive, and inserted into a hole into which adhesive has already been placed in a prior operation: "Installation of the adhesive insert anchor of the present invention begins with drilling a hole in the substrate, such as concrete, masonry, rock, or the like, to a predetermined depth. The hole is then cleaned using compressed air and a brush. After cleaning, a generous amount of *adhesive is inserted* (emphasis added) in the bottom of the hole. The anchor body is then twisted into the hole in order to agitate the adhesive in order to eliminate voids..." (col. 3, lines 3-10). "After hole 38 is cleaned, an *adhesive is added* (emphasis added) into hole 38, FIG. 6." (col. 8, lines 14 and 15).

Since Heminger does not teach the amended Claim 1 element of a fastener with an adhesive-coated outer surface, Heminger does not anticipate the invention of Claim 1. Claims 2-4, 6-11, 15, 20, and 23, dependent from Claim 1, enjoy the same distinctions from the prior art. Therefore, Applicant requests that the rejection be removed.

The Rejection of Claims 1-4, 9-11, 15, 20, and 24 Under 35 U.S.C. §102

In the Office Action of May 10, 2004, the Examiner rejected Claims 1-4, 9-11, 15, 20, and 24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,569,007 (Abraham). Applicant respectfully traverses the rejection.

Abraham does not disclose an outer surface having an adhesive thereon

Amended Claim 1 recites a fastener with an outer surface and at least a portion of the outer surface having an adhesive thereon. Abraham does not disclose this element. Instead, Abraham teaches an anchoring device without an adhesive-coated outer surface and the insertion of an adhesive in a separate step: "In a kit, all of the above elements would be provided, along with a suitable adhesive for securing the anchoring element within the hole in the substrate." (col. 2, lines 30-32). "Another advantage of the present invention is that it accommodates chemical anchors having adhesive in a capsule, as well as adhesives that may be delivered (into the hole in the substrate) by other means, such as by a caulk-gun. In this regard, the anchoring system of the present invention tends to be very flexible (i.e., it accommodates a number of adhesive delivery systems)." (col. 2, lines 61-67). "FIG. 1 shows an embodiment of the anchoring system 100 of the present invention. Generally, an anchoring element 102 is embedded within a hole 104 extending into the surface 106a of a substrate 106, and is secured within the hole 104 with a suitable adhesive 108 (shown as dots), such as with epoxy. *The adhesive may be inserted into the hole by any suitable means*, (emphasis added) such as by disposing a capsule of adhesive into the hole prior to inserting the anchor (anchoring) element 102, or by squirting adhesive into the hole such as with a caulk-gun." (col. 3, line 60 to col. 4, line 2).

Since Abraham does not teach the amended Claim 1 element of a fastener with an adhesive-coated outer surface, Abraham does not anticipate the invention of Claim 1. Claims 2-4, 9-11, 15, 20, and 24, dependent from Claim 1, enjoy the same distinctions from the prior art. Therefore, Applicant requests that the rejection be removed.

The Rejection of Claims 1, 3, 6-8, 15-17, and 25 Under 35 U.S.C. §102

In the Office Action of May 10, 2004, the Examiner rejected Claims 1, 3, 6-8, 15-17, and 25 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,082,405 (Witten). Applicant respectfully traverses the rejection.

Witten does not disclose an outer surface having an adhesive thereon

Amended Claim 1 recites a fastener with an outer surface and at least a portion of the outer surface having an adhesive thereon. Witten does not disclose this element. Instead, Witten teaches an insert, not coated with an adhesive, and inserted into a hole into which adhesive has already been placed in a prior operation: “To mount the element 10 in the panel, the *opening 48 first receives a quantity of epoxy adhesive* (emphasis added) 50. The element 10 is then inserted through the opening 44A formed in the outer skin 40 so that the epoxy 50 completely fills the opening 48 between the inner skin 44 and the outer skin 46, and surrounds and contacts all external surfaces of the element 10.” (col. 3, lines 45-51).

Since Witten does not teach the amended Claim 1 element of a fastener with an adhesive-coated outer surface, Witten does not anticipate the invention of Claim 1. Claims 3, 6-8, 15-17, and 25, dependent from Claim 1, enjoy the same distinctions from the prior art. Therefore, Applicant requests that the rejection be removed.

The Rejection of Claims 1, 2, 12-14, 21, and 22 Under 35 U.S.C. §102

In the Office Action of May 10, 2004, the Examiner rejected Claims 1, 2, 12-14, 21, and 22 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,853,841 (Castor et al.). Applicant has amended Claim 1 and respectfully submits that amended Claim 1 overcomes the rejection.

Castor does not teach the fasteners recited in Claim 1

Amended Claim 1 recites a fastener selected from the group including a rivet nut, a rivet nut stud, a threaded insert, and a blind threaded insert. Castor does not teach any of the fasteners recited in amended Claim 1. Instead, Castor teaches a group of completely different devices including a heavy-duty anchor, a heavy-duty dowel, a drilling cylinder, and a striking nail. All of Castor’s devices are very different in design, construction, and function than the fasteners recited in Claim 1.

Castor's fasteners are typically used in heavy-duty construction applications. Abstract of Castor: "A fastener for a *high strength connection with a substructure* (emphasis added) with a straddling dowel, drilling cylinder or nail for insertion into a substructure material, for example, of concrete, rock, wood or the like, is disclosed..." "FIG. 1 is a longitudinal section view, as shown in the upper half and a side elevational view shown in the lower half of a *heavy duty anchor* (emphasis added) including a nut and an adhesive coating; FIG. 2 is a longitudinal sectional view shown in the upper half and a side elevational view shown in the lower half of a *heavy duty dowel* (emphasis added) with a screw and an adhesive coating;" (col. 2, line 64 to col. 3, line 3). A typical use of an anchor is to attach a steel plate to a concrete slab.

The fastener recited in Claim 1 are not typically used in heavy-duty applications (e.g., anchoring a steel plate to a concrete slab) and is not typically inserted into a substructure material. Instead, as shown in Figures 11 through 17, the fastener typically is used to hold two layers of a material together by passing through aligned holes in the materials and expanding within the holes and in the space behind the second layer. However, the present invention fasteners can be inserted into a substructure material and in such applications, the present invention fasteners is no less different in design and construction that the devices taught by Castor.

Since Castor does not teach the amended Claim 1 element of a fastener selected from the group including a rivet nut, a rivet nut stud, a threaded insert, and a blind threaded insert, Castor does not anticipate the invention of Claim 1. Claims 2, 12-14, 21, and 22, dependent from Claim 1, enjoy the same distinctions from the prior art. Therefore, Applicant requests that the rejection be removed.

The Objection of Claims 5, 18, and 19 as Being Dependent Upon a Rejected Base Claim

In the Office Action of May 10, 2004, Claims 5, 18, and 19 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and

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any intervening claims. Applicant respectfully submits that amended Claim 1 overcomes the rejections under U.S.C. §102(b). Claims 5, 18, and 19 are dependent from Claim 1. Therefore, Applicant respectfully submits that Claims 5, 18, and 19 are now in condition for allowance, which action is courteously requested.

Notice of Non-Compliance Amendment (37 CFR 1.121)

The Examiner issued an August 25, 2004 Notice of Non-Compliance Amendment (37 CFR 1.121) regarding the amendments in Applicant's August 10, 2004 Amendment and Request for Reconsideration. Specifically, Claim 25 did not have the proper status identifier. Applicant filed an Amendment and Request for Reconsideration on August 31, 2004 regarding the above Notice.

The Amendment to the Claims Filed on 9/7/2004 Does Not Comply With the Requirements of 37 CFR 1.121(c)

In the Office communication of December 3, 2004, The Examiner stated that the amendment to the claims filed on 9/7/2004 does not comply with the requirements of 37 CFR 1.121(c), because the claims submitted 8/12/2004 were non-compliant and thus never entered.

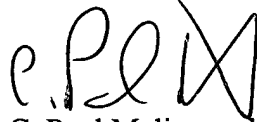
Applicant has submitted an Amendment and Request for Reconsideration responsive to the Office Action of May 10, 2004, the Office Action of August 25, 2004, and the Office communication of December 3, 2004. Applicant respectfully submits that this Amendment and Request for Reconsideration is in full compliance with 37 CFR 1.121(c).

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Conclusion

Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Paul Maliszewski'.

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